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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,447	01/14/2005	Minoru Oda	258187US0PCT	3216
22850 7590 09/30/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
KRUEER, KEVIN R				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
09/30/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/505,447

**Applicant(s)**

ODA ET AL.

**Examiner**

KEVIN R. KRUEER

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5 and 7-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 and 7-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 8/05/08

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5 and 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auclair (US 5,932,655) in view of Ueyama (US Pat 5,284,884) and Ueda (US 5,886,098).

Auclair teaches a thermoplastic molding composition which feature improved impact and reduced opacity. The composition comprises @35-75wt% of a copolymer matrix, (a) 1-29wt% of a grafted rubber with a weight average particle size of 0.05-.30um (abstract). The matrix (c) is herein relied upon to read on the claimed continuous phase and comprises styrene and methyl methacrylate in a ratio of 80:20 –65:35 (col 5, lines 48+). The grafted particle (a) comprises a grafted phase of styrene and methyl methacrylate (col 2, lines 20+) in relative amounts of 80:20-65:35. The core shell phase and grafted phase and grafted phase are included in amounts of 0.3-1 (col 2, lines 20+). The core-shell phase comprises 5-30wt% of a vinyl aromatic polymer (col 2, line 31) and 70-95wt% of a diene (col 2, lines 39) such as butadiene. Said core/shell is understood to read on said claimed "elastomer" and the particle is understood to read on the claimed dispersed stage.

Said refractive index difference between the continuous phase and the dispersed phase is not explicitly taught to be not more than 0.05. However, Auclair teaches opacity should be reduced. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to minimize the refractive index difference between the matrix and the particles in order to minimize opacity.

Auclair teaches the composition may contain an antistatic agent but does not teach said agent should be included in a second layer. However, Ueyama teaches antistatic agent may be coated on the surface of a substrate wherein the antistatic agent is dispersed in a resin composition comprised of the same resin as the substrate (col 1, lines 23+). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the substrate taught Auclair with a protective layer comprising said same resin composition and an antistatic agent. The motivation for doing so would have been because Ueyama teaches such a technique is known in the art for imparting antistatic properties to a substrate.

Auclair also does not teach the claimed antistatic agent. However, Ueda teaches claimed components B1-B3. Ueda teaches said components may be added to a thermoplastic composition in amounts of 3-40% in order to impart antistatic properties to said composition (abstract). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the antistatic agent taught in Ueda as the antistatic agent added to the protective layer taught by Auclair in view of Ueyama. The motivation for doing so would have been because Ueda teaches said composition gives such compositions excellent antistatic properties.

With respect to claims 5 and 6, said claim does not specify the substrate comprises a total of 100 parts by weight. Thus, the examiner takes the position that the composition taught in Auclair still reads on said claimed relative amounts of continuous phase and dispersed phase.

With regards to claim 7, the examiner takes the position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the thickness of the laminate according to the desired end use. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the relative thickness of the protective layer depending upon the desired resistivity.

With respect to claim 8, the examiner takes the position said limitation is inherently met since the surface layer and the substrate layer comprise the same composition.

With respect to claims 10-14, the examiner takes the position that the preamble limitations do not inherently introduce structure to the claim thus distinguishing the claimed invention from the invention taught in the prior art.

With regards to claim 15, the method of making a product does not patentably distinguish a claimed product from the prior art unless it can be shown that the method of making the product inherently results in a materially different product. No such showing has been made.

With regards to claim 17, it would have been obvious to the skilled artisan to select the weight of the blocks in order to optimize particle size and hardness.

***Response to Arguments***

Applicant's arguments filed June 11, 2008 have been fully considered but they are not persuasive.

Applicant argues the references individually fail to disclose a laminate comprising a substrate and surface layers formed on each side of the substrate. The examiner agrees but notes no single reference was relied upon for said teaching. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further argues the prior art fails to teach the claimed total thickness and the claimed relative thickness. The examiner agrees and took the position that it would have been obvious to vary the overall thickness and the relative thicknesses of the surface layers. Applicant has provided no argument as to why the examiner erroneously reached said conclusion. The rejection is, therefore, maintained.

Applicant further argues the current claims require that the surface layer "consists essentially" of the claimed composition and that said transitional phrase "excludes the use of elastomers in the surface layer." Said statement, however, is insufficient to meet applicant's burden with regards to demonstrating elastomers are excluded because they materially affect the basic and novel characteristics of the claimed invention. Therefore, the transitional phrase is read to be equivalent to "comprising" for the purposes of examination.

Applicant argues the object of the present invention is to obtain a multi-layer sheet comprising a substrate layer and a surface layer wherein different MBS resin compositions are used of each layer. Said argument is noted but is not persuasive because it is not commensurate in scope with the claims.

Applicant further argues the claimed laminate exhibits unexpected results which patentably distinguishes the claimed product from the prior art. Specifically, Tables 6 and 7 are said to show comparative examples 3 and 4 which are poor in transparency. However, said argument is not commensurate in scope with the claims because the improved transparency is said to be due to a lack of elastomer on the surface side of the laminate but the claims do not exclude the presence of elastomeric materials for the surface layers.

With respect to claim 7, table 3 of the specification has been fully considered but said data fails to establish unexpected results. If applicant believes the examiner erred in the analysis, applicant's response must explain the data in table 3 and why said showing is sufficient to establish unexpected results.

For the reasons noted above, the rejections are maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN R. KRUEER whose telephone number is (571)272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached at 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin R. Krueer/  
Patent Examiner-Art Unit 1794



